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08/860,007    08/04/97    BERSCHEID

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EXAMINER

020736    HM31/0610  
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WASHINGTON DC 20036-3307

CHIPPEN, M    PAPER NUMBER

1621  
DATE MAILED:

06/10/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/860,007**

Applicant(s)  
**Berscheid et al.**

Examiner  
**Michael L. Shippen**

Group Art Unit  
**1621**



☒ Responsive to communication(s) filed on Mar 19, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 8 and 13-25 is/are pending in the application

Of the above, claim(s) 19 and 20 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 8, 13-18, and 21-25 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

The indicated allowability of claims 9 and 10 (and the amended claims corresponding thereto) is withdrawn in view of the newly discovered reference(s). Rejections based on the newly cited reference(s) follow.

#### ***Election/Restrictions***

Claims 19 and 20 stand withdrawn from consideration as not reading upon the elected species, see M.P.E.P. § 803.02

#### ***Claim Rejections - 35 USC § 112<sup>1</sup>***

Claim 15 is rejected under 35 U.S.C. § 112, first and second paragraphs. The process steps as recited in the claims will not afford products wherein  $R_1$  is not hydrogen or products wherein  $n$  is 2. A process for carrying out the claimed process to afford such products is not disclosed nor enabled in the specification as filed. If one has to carry out additional process steps to obtain such

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1

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 112 that form the basis for the rejections under this section made in this Office action:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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products, such critical reaction steps and conditions are not set forth in the claim which makes the claim to fail to particularly point out the claimed invention.

***Claim Rejections - 35 USC § 102<sup>2</sup>***

Claims 21-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Hopp (USP 4,110,430, newly relied upon). Note the examples.

***Claim Rejections - 35 USC § 103<sup>3</sup>***

Claims 8, 14-18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hopp (USP 4,110,430, newly relied upon). The reference is applied as above. The reference teaches active agents that differ from the active agent recited in the claims only as to the position of the alkyl

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2

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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group on the benzene ring. Such agents are isomeric and so structurally similar that one would expect the respective agents to possess a community of properties in common render such a modification of the prior art compounds obvious. Further, the prior art active agents are homologous to the claimed compounds with respect to the alkyl group on the benzene ring, the  $R_1$  group, the  $R_2$  group and/or the value of  $n$ . Homologues are a class of compounds differing only by methylene linkages and possessing similar structures. Compounds of a homologous series are recognized as possessing a community of properties in common. Accordingly, it would have been obvious to one of ordinary skill in the art to interchange of these homologous substituents in the prior art active agent would afford closely related structures and agents possessing similar properties.

Claims 8, 13-18 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sipos (USP 4,321,257, newly cited). The reference generically teaches the claimed compounds or active agents, note the phenyl alkanols given at the bottom of column 4. Also, note the agents specifically referred to in lines 43-51 of column 5. The reference does not specifically exemplify the instant compound. However, the generic teaching indicates to one of ordinary skill in the art that species falling within the generic disclosure, including the instantly claimed compound, would possess the prior art use. It is well within the skill of the artisan to select among the alternatives of the reference to afford compounds possessing the prior art use, *In re Lemin*, 141 USPQ 814. Also, the reference teaches active agents that differ from the active agent recited in the claims only as to the position of the substituents on the benzene ring. Such agents are isomeric and so structurally similar that one would expect the respective agents to possess a community of properties in common render

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such a modification of the prior art compounds obvious. Furthermore, the prior art active agents are homologous to the claimed compounds with respect to the alkyl groups on the benzene ring, the R<sub>1</sub> group, the R<sub>2</sub> group and/or the value of n. Homologues are a class of compounds differing only by methylene linkages and possessing similar structures. Compounds of a homologous series are recognized as possessing a community of properties in common. Accordingly, it would have been obvious to one of ordinary skill in the art to interchange of these homologous substituents in the prior art active agent would afford closely related structures and agents possessing similar properties.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hafner (USP 4,968,668, newly cited) in view of Vogel ("A Textbook of Practical Organic Chemistry", newly cited). Hafner teaches an analogous process that differs from the claimed process in that prior art does not recite step (a) and some of the reactants differ as to the substituents present. The recited step (a) is a standard textbook method of preparing the alkylmalonates that would be used in the Hafner process. No patentable significance is seen in reciting a standard method of preparing a known starting material that would be used in the prior art process. Moreover, with respect to multi-step synthetic procedures involving a combination of individually well known chemical reactions, it has been held that one of ordinary skill in the relevant art is charged with knowledge of the individual chemical reactions and their combination to produce a desired end product would have been obvious, *In re Payne*, 203 USPQ 245; *In re Winslow*, 151 USPQ 48; *In re Kamlet*, 88 USPQ 106. The differences in the reactants is found only in substituents that are removed from the reaction site and do not affect the outcome of the reaction. The reactive functional groups involved are the same and

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undergo the same conversion. The claimed process affords the products one would expect from the teaching of the prior art. The use of a new starting material in an otherwise old process is considered obvious.

*Conclusion*

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group **Art Unit 1621**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael L. Shippen** whose telephone number is **(703) 308-4635**. The Examiner's normal tour of duty is 8:00 AM to 4:30 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1235**. The Examiner's supervisor, **Gray Geist**, may be reached at **(703) 308-1701**. The official group FAX machine number is **(703) 308-4556**.

MShippen  
June 7, 1998

**MICHAEL L. SHIPPEN  
PRIMARY EXAMINER  
ART UNIT 1621**